## REMARKS

This application has been carefully reviewed in light of the Office Action of July 26, 2004, wherein:

A.      Claims 1-5, 7-13, and 15-16 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,920,856 to Syeda-Mahmood, herein referred to as the "Syeda-Mahmood patent;" and

B.      Claims 14 and 16 were rejected under 35 U.S.C. §103(a) as being unpatentable over the Syeda-Mahmood patent in view of U.S. Patent No. 6,584,479 to Change et al., herein referred to as the "Chang patent."

The Applicants note that the Office Action Dated January 12, 2005 is a Final Office Action. Further, the Applicants are submitting this reply within the two month deadline.

## Claim Rejections

A.      Claims 1-5, 7-13, and 15-16 were rejected under 35 U.S.C. §102(b) as being anticipated by the Syeda-Mahmood patent

*Regarding Claim 1*

In response to the Applicants' arguments, the Examiner further clarified his position starting on page 6 of the pending Office Action. First, the Applicants wish to clarify the prosecution record by pointing out that the preamble of Claim 1 states, "[a]n apparatus for automatically extracting metadata from electronic documents." In the first sentence of the second full paragraph on page 6 of the pending Office Action, the Examiner stated that he "refers to figure 1 to show the preamble of the claim." The Applicants believe that the Examiner is mistaken as to what is contained in the preamble. The Applicants respectfully submit that the preamble ends with the term before the transition word "comprising." Thus, the preamble of Claim 1 states, "[a]n apparatus for automatically extracting metadata from electronic documents." Further, the Applicants submit that FIG. 1 of the Syeda-Mahmood patent does not disclose an apparatus for automatically extracting metadata from electronic documents.

In order to establish a prima facie case of anticipation, the Examiner must set forth an argument that provides (1) a single reference (2) that teaches or enables (3) each of the claimed

elements (as arranged in the claim) (4) either expressly or inherently and (5) as interpreted by one of ordinary skill in the art. All of these factors must be present, or a case of anticipation is not met. Thus, "[a]nticipation requires that every element of the claims appear in a single reference …" Continental Can Co. v. Monsanto Co. 948 F.2d 1264 (Fed. Cir. 1991)..

Claim 1 claims, in part, "said first processing element is further configured to convert electronic documents into files; said first processing element is configured to provide the files to a second processing element; said second processing element is configured to receive said files and extract predetermined information; said second processing element is further configured to provide said extracted predetermined information to said reasoning element; said database is configured to also provide input to said reasoning element; said reasoning element is configured to use a set of rules to extract metadata from the files; and said reasoning element provides an output of metadata." In order for the prior art to anticipate the claims, a single reference must teach each of the claim elements as arranged in the claim. The Applicants submit that the art cited by the Examiner does not teach each of the elements as arranged in the claim.

First, the Applicants respectfully point out that that system disclosed in the Syeda-Mahmood patent is very different than the system claimed in the present application. Looking to the abstract, the Syeda-Mahmood patent discloses a network server which interfaces a client with selected database sites from a plurality of database sites. The network server comprises a meta-database, a search agent, and a refining module. The search agent indexes the meta-database with a user query obtained from the client, and then distributes queries, developed pursuant to such indexing, to the selected ones of the plurality of database sites. A refining module is used to update the meta-database with the database relevancy information. The Applicants submit that this is very different from an apparatus for automatically extracting metadata from electronic documents, wherein said second processing element is configured to provide extracted predetermined information to a reasoning element, and the reasoning element is configured to use a set of rules to extract metadata from the files.

The Applicants look to the elements as arranged in Claim 1. Claim 1 claims, in part, a first processing element configured to convert electronic documents into files, a second processing element configured to receive the files and extract predetermined information, and a reasoning element configured to use a set of rules to extract metadata from the files, where the reasoning element provides an output of metadata. In the Examiner's rejection of Claim 1, the Applicants understand that the Examiner has analogized the first processing element to the translator module

of the Syeda-Mahmood patent, the second processing element to the search agent of the Syeda-Mahmood patent, the predefined information to the query patterns of the Syeda-Mahmood patent, or alternatively to metadata of the Syeda-Mahmood patent, and the reasoning element to the refining module or alternatively the search agent of the Syeda-Mahmood patent. The Applicants apologize for their confusion as to which elements of the Syeda-Mahmood patent the Examiner asserts anticipate which elements of the present claims. However, the Examiner appears to have said one thing in his rejection of the claims, and yet another thing when responding to the Applicants' arguments.

If the Examiner is correct and the various components of the Syeda-Mahmood patent anticipate the elements in Claim 1, then, following the Examiner's logic, the Syeda-Mahmood patent must teach that the translator module converts electronic documents into files, the search agent receives the converted files and uses query patterns to extract predetermined information or the search agent receives the converted files and extracts metadata, and the refining module or the search agent uses a set of rules to extract metadata from the files, where the refining module provides an output of metadata. The Applicants submit that the Syeda-Mahmood patent does not operate in the manner described above. Instead, the Applicants submit that the Syeda-Mahmood patent teaches a method of querying databases and web-sites for information, storing and updating that information, and then retrieving that information at a later time.

First, the Applicants note that the Examiner cannot claim that the search agent of the Syeda-Mahmood patent is both the second processing element and the reasoning element. If the Examiner states that the search agent is the second processing element, and the search agent extracts metadata (i.e., predetermined information), then how does the Examiner anticipate the element of the reasoning element is configured to use a set of rules to extract metadata from files? The Applicants respectfully request in the Examiner's response that he clarify exactly how he is interpreting the Syeda-Mahmood patent to teach each element of Claim 1.

Col. 7, lines 15-17 of the Syeda-Mahmood patent state that the user query may have to be transformed by a translator module into forms the respective databases expect. Thus, the Syeda-Mahmood patent teaches that the translator module changes a query from one query language to another query language, much like a Spanish translator will translate Spanish into English. The Applicants submit that this is not the same thing as "converting electronic documents into files." Thus, the Applicants submit that the Syeda-Mahmood patent does not teach, disclose or suggest a

first processing element configured to convert electronic documents into files, as is claimed in Claim 1.

Col. 6, lines 30-35 of the Syeda-Mahmood patent state that the role of the search agent 5 is to not only distribute queries to relevant database sites 8 after indexing into the meta-database 4, but to also assemble and return the data-base responses back to the user 6. The Applicants submit that this is not the same thing as "said second processing element is configured to receive files and extract predetermined information." The Applicants submit that the Syeda-Mahmood patent teaches that the search agent distributes queries. Thus, the search agent requests predetermined information, but does not receive files and extract predetermined information as is claimed in Claim 1.

Col. 5, lines 33-36 of the Syeda-Mahmood patent state that the refining module 7 (also refereed to as training or learning module) associates patterns of responses from the databases to queries to learn the relevance of database sites 8 for similar further queries. Further, col. 6, lines 33-36 state that the search agent 5 relays the query data patterns and the database responses to the refining module 7 for site and scope relevancy updation. The Applicants do not know where in the Syeda-Mahmood patent the Examiner has found support for the refining module 7 extracting metadata from the files, and outputting the metadata. For example, col. 7, lines 36-39 state that the output of the refining module is a probability value indicating the likelihood of a database returning useful results for a given query. Thus, the Applicants submit that the Syeda-Mahmood patent does not teach, disclose or suggest "said reasoning element is configured to use a set of rules to extract metadata from the files; and said reasoning element provides an output of metadata," as is claimed in Claim 1.

*Regarding Claim 3*

In his rejection of Claim 3, the Examiner stated that the Syeda-Mahmood patent discloses an apparatus for automatically extracting metadata from electronic documents, wherein said predetermined information is substantially spatial layout facts, pointing to col. 9, lines 51-67 and col. 10, lines 15-36. The Applicants respectfully disagree with the conclusion drawn by the Examiner.

First, as noted above, the Examiner has indicated that the predetermined information is analogous to the query template or metadata in the Syeda-Mahmood patent. Col. 9, lines 51-67 deal with image feature extraction, which includes method for extracting information about edges,

curves, color, texture, etc. Col. 10, lines 15-36 deal with image organization, specifically, clustering of image data and spatial information. However, it is important to refer back to Claim 1 to understand Claim 3. Claim 1 claims, in part, "said second processing element is configured to receive said files and extract predetermined information, said second processing element is further configured to provide said extracted predetermined information to said reasoning element." Claim 3 claims, said predetermined information is substantially spatial layout facts. Thus, in order for the Syeda-Mahmood patent to anticipate Claim 3, it must teach that said second processing element is configured to receive said files and extract substantially spatial layout facts, and said processing element is further configured to provide said extracted substantially spatial layout facts to said reasoning element. Col. 9, lines 51-67 discloses extracting information about images such as edges, curves, color and texture. The Applicants submit that this does not anticipate said second processing element is configured to receive said files and extract substantially spatial layout facts, and said processing element is further configured to provide said extracted substantially spatial layout facts to said reasoning element of Claim 3. Further, col. 10, lines 16-36 teaches clustering image and spatial information, which the Applicants submit is not said second processing element is configured to receive said files and extract substantially spatial layout facts, and said processing element is further configured to provide said extracted substantially spatial layout facts to said reasoning element of Claim 3. Thus the Applicants submit that Claim 3 is patentable over the cited prior art.

*Regarding Claims 2-8*

Claims 2-8 are dependent upon Claim 1. For the reasons given above, the Applicants submit Claim 1 is patentable over the cited prior art. Therefore, the Applicants submit that Claims 2-8 are also patentable over the cited prior art at least through their dependency on an allowable base claim.

*Regarding Claims 9-16*

Claim 9 is similar to Claim 1. Thus, the same arguments presented above in support of Claim 1 may also be applied to Claim 9. Therefore, the Applicants submit that Claim 9 is also patentable over the cited prior art.

Claims 10-16 are dependent upon Claim 9. As previously mentioned, the Applicants submit that Claim 9 is patentable over the cited prior art. Therefore, the Applicants submit that Claims 10-16 are also patentable over the cited prior art at least through their dependency upon an allowable base claim.

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**Concluding Remarks:**

The Applicant respectfully submits that in light of the above comments and remarks, all

claims are now in allowable condition. The Applicant thus respectfully requests timely

10      allowance of all of the pending claims.


In the event the Examiner wishes to discuss any aspect of this response, or believes that a

conversation with either Applicant or Applicant's representative would be beneficial the

Examiner is encouraged to contact the undersigned at the telephone number indicated

15      below.


The Commissioner is authorized to charge any additional fees which may be required or

credit overpayment to deposit account no. 50-2691. In particular, if this response is not

timely filed, the Commissioner is authorized to treat this response as including a petition

20      to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of

the number of months necessary to make this response timely filed. The petition fee due

in connection therewith may be charged to deposit account no. 50-2691.


                                              Respectfully submitted,

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